

Remarks

The above Amendments and these Remarks are in reply to the Office action mailed October 8, 2003. With the cancellation of Claim 7, the previous cancellation of Claim 21 and the addition of Claims 25-67, Claims 3-6, 8-20 and 22-67 are presented herewith for consideration.

Objection to the Drawings

The drawings have been objected to for failing to show every detail recited in the claims. In particular, the Examiner has indicated that the female-to-female connector was not shown in the drawings. Applicant has amended Claim 6 and canceled Claim 7 so that all references in the claims to a female-to-female connector and a male-to-male connector have been deleted.

Instead, Claim 6 as amended now refers to “a connector piece for connecting first and second snap portions of the first plurality of snap portions.” The feature of a connector piece is shown in the drawings. In one embodiment, the first plurality of snap portions may be female snap portions. In such an embodiment, the connector piece recited in amended Claim 6 may be a male/male connector piece for snapping together first and second female snap portions of the plurality of female snap portions. Such a male/male connector piece is shown in Figs. 6 and 7 as male/male connector piece 136. Thus, the claimed connector piece in amended Claim 6 is shown in the drawings. Applicant notes that there is no requirement under the applicable patent laws or the MPEP that the drawings show each embodiment covered by the claims. The showing of one embodiment is sufficient.

Rejection of Claims 6 and 7 Under 35 U.S.C. §112, First Paragraph

Claims 6 and 7 have been rejected under 35 U.S.C. §112, first paragraph, for failing to provide an enabling disclosure of the male-to-male connector or the female-to-female connector. As indicated above, Claim 7 has been canceled and Claim 6 has been amended so that all reference to a male-to-male connector and a female-to-female connector has been deleted. Claim 6 as amended now refers to “a connector piece for connecting first and second snap portions of the first plurality of snap portions.” Applicant respectfully submits that the specification as filed included an enabling disclosure of the claimed connector piece, as the connector piece is disclosed in the application in both the drawings and text, is a very simple and known mechanism, and a skilled artisan would be able to make and use the connector with little or no experimentation.

To be enabling, the specification must include sufficient disclosure to allow one of skill in the relevant art to make and use the invention, without undue experimentation, relying on the patent specification and the knowledge in the art at the time the specification was filed. *Scripps Clinic Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991). There are several factors which are used in determining whether the amount of experimentation makes the specification non-enabling, notably among them the predictability in the art. With respect to mechanical inventions, the operation and composition of inventions are generally considered predictable, and as such, broad generic claims in mechanical inventions are generally considered to be enabled by disclosure of a single or relatively few embodiments. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533 n.5 (Fed. Cir.), *cert. denied*, 484 U.S. 954 (1987). The Federal Circuit has stated:

applicant's specification must enable one of ordinary skill in the art to practice the full scope of the claimed invention. Wright, 999 F.2d at 1561. That is not to say that the specification itself must necessarily describe how to make and use every possible

variant of the claimed invention, for the artisan's knowledge of the prior art and routine experimentation can often fill gaps, interpolate between embodiments, and perhaps even extrapolate beyond the disclosed embodiments, depending upon the predictability of the art.

AK Steel Corporation v. Sollac, 344 F.3d 1234 (Fed. Cir. 2003).

The present invention relates to an extremely simple mechanical invention. A first object may be snapped together to a second object by snap portions provided on the first and second objects. In particular, in embodiments of the invention, a male portion (126) on a first object snaps together with a female portion (128) on the second portion. Although a snap for accomplishing this was well known in the art at the time of the invention, the specification goes into detail about the structure and operation of the male and female snap portions:

Each of the various appendages and body parts can be made detachable by snaps as shown in Fig. 2. The snaps comprise a male portion 126 and a female portion 128. It is understood that the respective positions of the male and female snap portions may be reversed in alternative embodiments. The male and female portions 126, 128 may be affixed to the plush portions of the toy by known fastening schemes such as by sewing or by adhesive.

The snaps formed by portions 126 and 128 may be of conventional design, and preferably formed of durable plastic and/or metal. Those of skill in the art would appreciate that the material hardness and the relative sizes of the portions 126 and 128 are selected so that an audible “snap” is produced when an appendage is detached from the torso (or body parts are otherwise separated). A similar snapping sound may also be produced upon reattaching the appendage or body part.

As is known in the art, the male snap portion 126 includes an annular wall 130 defining a central aperture 132. The height of annular wall 130 is provided to match the depth of a recess 134 formed in the female portion 128 so that the male and female portions may snap together. Different audible snapping tones may be obtained by varying the overall size of the snap, as well as the height of wall 130 and the corresponding depth of recess 134. In an alternative embodiment, it is contemplated that the male and female portions 126, 128 emit no appreciable sound upon detaching from, and reattaching to, each other.

In addition to each gratifying “snap” upon assembly and disassembly of a toy, the snaps provide the further function of allowing the appendages to rotate with respect to the torso. Thus, a toy’s arms and legs can swing and its head can turn, and a toy can be moved into a variety of positions.

Specification, page 9, line 17 – page 11, line 3. The described male snap portion 126 is also clearly shown in at least Figs. 2, 3 and 5. The described female snap portion is similarly clearly shown in at least Figs. 2, 3 and 5.

In accordance with a further aspect of the present invention, it may be desirable to attach a first object having a female snap portion to a second object also having a female snap portion. As two female snap portions cannot directly attach to each other, the specification discloses a male/male connector piece 136. Similarly, in accordance with the present invention, it may be desirable to attach a first object having a male snap portion to a second object also having a male snap portion. As two male snap portions cannot directly attach to each other, the specification discloses a female/female connector piece.

The claimed connector piece is disclosed in the application and is shown in the figures. In particular, in one embodiment, the connector piece comprises the male/male connector piece 136 described in the specification at page 13, lines 5-19 and shown in both Figs. 6 and 7. As implied by its name and as shown in the figures, the connector piece 136 is formed by two male portions formed, back-to-back, as a unitary piece so as to allow two female snap portions to be joined. The skilled artisan would also know that the female/female connector piece could be made in the same way, *i.e.*, two female sections formed, back-to-back, as a unitary piece so as to allow two male snap portions to be joined. Thus, an enabling disclosure of these pieces is provided.

In addition, male/male snap connectors are well known in the art as simple mechanisms for connecting two female snap portions together. Similarly, female/female snap connectors are well known in the art as simple mechanisms for connecting two male snap portions together. It would be well within the skill of an average artisan to make and use both a male/male snap connector piece and a female/female snap connector piece for the purpose disclosed in the specification. As noted by the Federal Circuit, for simple, predictable mechanical inventions, the artisan's knowledge of the prior art and routine experimentation can be used to fill any gaps. *See, AK Steel Corporation, supra.*

Given the simplicity and predictability of snap connectors, the existence and well known structure of male/male and female/female connectors in the art at the time of the invention and the disclosure of the male/male, female/female snap connectors in the application, it is respectfully submitted that one of average skill in the art would easily understand how to make and use the disclosed male/male and female/female snap connectors in accordance with the present invention with little experimentation or no experimentation at all.

In view of the above, it is respectfully requested that the rejection of Claims 6 and 7 as non-enabling be withdrawn.

Rejection of Claims 3-20, 22 and 23 Under 35 U.S.C. §112, Second Paragraph

Claims 3-20, 22 and 23 have been rejected under 35 U.S.C. §112, second paragraph, for failing to particularly point out and distinctly claim the invention.

In particular, Claim 3 has been rejected on the grounds that the number of snapable elements is unclear. Applicant has clarified that at least two snapable elements are required.

Claim 6 has been rejected on the grounds that it is unclear how the male-to-male connector connects male portions of the snapable elements. Claim 6 has been clarified to replace male-to-male connector with “a connector piece.” A connector piece has express support in the specification (see specification at page 13, lines 5-19). The claimed connector piece may be a female/female connector piece for connecting two male snap portions together, or the connector piece may be a male/male connector piece for connecting two female snap portions together. Such connector pieces are well known in the art, and it is respectfully submitted that this term is clear and definite. Upon reading the specification, as set forth above, and it would be clear to one of skill in the art how to provide such a connector piece.

Claim 7 has been rejected on the grounds that it is unclear how the female-to-female connector connects female portions of the snapable elements. Claim 7 has been canceled from the application.

Claim 8 has been rejected for failing to provide antecedent basis for “said snap portion.” Claim 8 has been amended to overcome this rejection.

Claim 22 has been rejected for failing to provide antecedent basis for “said first snap portion,” and “said second and third snap portions.” Claim 22 has been amended to overcome this rejection.

Claim 23 has been rejected for being unclear because the possibility in lines 2 and 3 of the claim of only a male snap portion, only a female snap portion or only a male and female snap portion is inconsistent with other portions of the claim. Claim 23 has been amended to make clear the number of snap portions that are recited (namely, a first plurality of snap portions and a second

plurality of snap portions). Moreover, Claim 23 has been rejected because it was alleged to be unclear what toys were encompassed in the variety of different looking toys which are not included in the toys listed in lines 15-30. Applicant has amended Claim 23 to remove the recitation of a variety of different looking toys. It is believed the claim as amended overcomes the rejection on these grounds.

On page 3 of the Office action, in the preamble to the basis for rejecting the claims under Section 112, Second Paragraph, the Examiner indicated that “Claims 3-20, 22 and 23” were rejected. However, when setting forth the specific grounds for rejecting the claims under Section 112, Second Paragraph, there was no basis set forth for rejecting independent Claim 9, and Claims 10-20 dependent thereon. In a telephone conversation with the Examiner, the Examiner indicated that Claim 9, and Claims 10-20 dependent thereon, were rejected under Section 112, Second Paragraph on the same grounds as Claim 3. Claim 3 was rejected under Section 112, Second Paragraph as it was alleged to be unclear whether one snapable element or a plurality of snapable elements were claimed (as indicated above, Claim 3 has been amended to clarify that two snapable elements were claimed). Claim 9 is clear that a plurality of snapable elements are claimed. Therefore, it is respectfully requested that the rejection of Claim 9 on these grounds be withdrawn.

Rejection of Claim 23 Under 35 U.S.C. §102(b)

Turning now to the prior art rejections, Claim 23 is rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,506,328 to Alger (“*Alger*”).

Alger discloses a toy human figure where portions of the figure are removable. *Alger* does

not disclose, teach or in any way suggest the feature of snap portions of different sizes, and a universal snap portion capable of mating with each of the snap portions of different sizes. These features are discussed in the present application at page 19, line 16 through page 22, line 7. As disclosed therein, different size snap portions may be provided for different snapable elements. In order to provide complete interchangeability of all snapable elements, a universal snap is disclosed which allows snap portions to snap together regardless of their size. Thus, for example, a single female snap portion may mate with different sized male snap portions, and a single male snap portion may mate with different sized female snap portions.

The Examiner stated in the Office action that *Alger* “appears to show lugs 16 being a different size than peg 32.” These elements are shown in Fig. 5. Lugs 16 on the upper portion of the arm fit in aperture 18 on the shoulder of the toy. Peg 32 on the bottom of the head fits within aperture 34 on the neck of the toy. However, the lugs 16 and peg 32 fail to disclose or in any way suggest to a skilled artisan snap portions of different sizes as expressly called for in Claim 23, and the lugs 16 and peg 32 fail to disclose or in any way suggest to a skilled artisan a universal snap portion that is capable of mating with snap portions of different sizes as expressly called for in the Claim 23. For example, there is no disclosure, teaching or suggestion that the lug 16 on the arm would fit within the aperture 34 on the neck or other apertures of the toy, and there is no disclosure, teaching or suggestion that the peg 32 on the bottom of the head would fit within the aperture 18 on the shoulder or other apertures of the toy. In fact, it would be clear to the skilled artisan that the lug 16 and the peg 32 could not fit with apertures of different sizes.

For a reference to anticipate a patent claim, each and every limitation recited in the claim must be disclosed entirely within the reference. *Rockwell Intern. Corp. v. U.S.*, 147 F.3d 1358, 1363

(Fed. Cir. 1998). Omission of any claimed element, no matter how insubstantial, is grounds for traversing a rejection based on §102. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983). As the cited reference fails to disclose the above-discussed features, the reference cannot anticipate the invention recited in Claim 23. It is therefore respectfully requested that the rejection of Claim 23 on the stated grounds be withdrawn.

Rejection of Claims 3, 6 and 7 Under 35 U.S.C. §103(a)

Claims 3, 6 and 7 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 1,566,801 to Millard ("*Millard*") in view of U.S. Patent No. 3,597,801 to Ogsbury ("*Ogsbury*").

Claim 3, and Claims 6 and 7 dependent thereon, have been amended to recite in part a toy including snapable elements and snap portions, the snap portions recited as:

a plurality of snap portions affixed to the at least two snapable elements, the plurality of snap portions including a first plurality of snap portions and a second plurality of snap portions, said first plurality of snap portions capable of mating with and detaching from said second plurality of snap portions with an audible snapping sound, at least one of the first plurality of snap portions capable of mating with a number of different size snap portions from the second plurality of snap portions

For the same reasons discussed above with respect to Claim 23, *Millard* and *Ogsbury*, taken singly or in combination with each other, fail to disclose or in any way suggest to a skilled artisan a toy including a snap portion that is capable of mating with snap portions of different sizes as expressly called for in the Claims 3, 6 and 7 as amended.

It is therefore respectfully requested that the rejection of Claims 3, 6 and 7 on the stated grounds be withdrawn.

Rejection of Claims 3, 8 and 22 Under 35 U.S.C. §103(a)

Claims 3, 8 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable *Alger* in view of *Ogsbury*.

As discussed above, each of the claims as amended recites a toy including in part a snap portion (a “universal” snap portion in the case of Claim 22) capable of mating with a number of different size snap portions. Neither *Alger* nor *Ogsbury*, taken singly or in combination with each other, teach or in any way suggest to a skilled artisan a toy including a snap portion that is capable of mating with snap portions of different sizes as expressly called for in the Claims 3, 8 and 22 as amended.

It is therefore respectfully requested that the rejection of Claims 3, 8 and 22 on the stated grounds be withdrawn.

Rejection of Claim 4 Under 35 U.S.C. §103(a)

Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Millard* in view of *Ogsbury*, and further in view of U.S. Patent No. 5,788,554 to Goodwin (“*Goodwin*”). However, Claim 4 depends on Claim 3, and as such distinguishes over the combination of *Millard* and *Ogsbury* as explained above. *Goodwin* adds nothing to the teaching *Millard* and *Ogsbury* with regard to a snap portion that is capable of mating with a plurality of different size snap portions.

Therefore, it is respectfully submitted that Claim 4 is patentable over the combination of *Millard*, *Ogsbury* and *Goodwin*, taken alone or in combination with each other, and it is respectfully requested that the rejection of Claim 4 on the stated grounds be withdrawn.

New Claims

Applicant has added new claims 25-67.

New independent Claims 25, 34 and 42 are each substantially similar to allowed Claim 24, with the difference that independent Claims 25, 34 and 42 each recite four pluralities of parts where Claim 24 recites twelve pluralities of parts. Claims 26-33, 35-41 and 43-48 dependent on Claims 25, 34 and 42, respectively, recite additional pluralities of parts.

New Claims 49-51 are substantially similar to allowed Claim 24, in that each recites a toy which is snapped together from a plurality of parts with a snap portion capable of snapping together with other snap portions of different sizes. However, Claim 49 provides for the possibility of less than all of the different pluralities of parts. Claim 50 recites that the parts may be snapped together to form one or more of a group of figures. And Claim 51, and claims dependent thereon, recite that at least two of the various recited pluralities of parts are snapped together.

New Claim 55 and claims dependent thereon recite a toy formed of a toy torso, toy arm, toy leg and toy head, where the toy torso includes a universal snap portion capable of snapping together with snap portions on the toy arm, leg and head of different sizes.

As explained above, a toy having interchangeable parts where one part can attach to other parts with snap portions of different sizes is not disclosed, shown or in any suggested in the cited references. The new claims are therefore believed to be patentable over the cited references. No new matter has been added.

Based on the above amendments and these remarks, reconsideration of Claims 3-6, 8-20 and 22-24, and consideration of Claims 25-67, is respectfully requested.

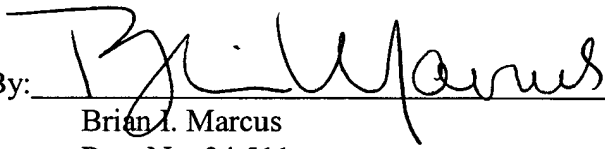
The Examiner's prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned attorney by telephone.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond up to and including today, April 8, 2004.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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